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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,765	02/20/2002	Kazuhiro Ishida	017446-0323	3462
22428 7590 01/24/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/077,765

Applicant(s)

ISHIDA, KAZUHIRO

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,9,10 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,10 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 10/12/2007.
2. Claims 1-2, 5-6, 9-10 and 13-15 are present for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-6, 9-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (5,987,424 hereinafter Nakamura) in view of Kenney (5,514,424 hereinafter Kenney).

With respect to claims 1, 5, 9 and 13-15, Nakamura teaches an advertisement system (Abstract). A portable telephone communication terminal capable of communicating with other portable communication terminals utilizing a display on said portable communication terminal, and capable of automatically displaying an advertisement on said display when said display is operating in a stand by mode (see step 206); a terminal management device for managing said portable telephone communication terminal (exchange 4); an advertisement broadcast device for storing advertisement data provided by an advertisement broadcaster (see figure 2); notification means for when a registration request including first information representing that said portable telephone communication terminal is an automatic advertisement display

terminal and a second information representing an advertisement broadcaster designated by said portable telephone communication terminal is issued by said portable telephone communication terminal, notifying said advertisement broadcaster device of the registration request including the first information in accordance with the second information (i.e. the subscriber registers to receive the advertisement from an issuer)(steps 1301 and 1302); display control means for, when advertisement data is received from said advertisement broadcast device which is a registration acceptance notification source, transmitting the received advertisement data to said portable telephone communication terminal on the basis of the registered first information and the registered second information, and wherein the portable telephone communication terminal is configured to automatically receive the advertisement data from the terminal management device and is configured to automatically display the advertisement data display of said portable telephone communication terminal (see Figure 14).

With respect to a plurality of advertisement broadcast devices, each advertisement broadcast device of the plurality of advertisement broadcast devices capable of storing advertisement data provided by a corresponding advertisement broadcaster of a plurality of advertisement broadcasters (see Figure 2, items 5, 6, 7, 8 and 9).

With respect to registration means for registering the first information and the second information when said advertisement broadcast device send registration acceptance in response to the registration request notification from said notification means. Nakamura teaches telephone sets 1 and 11 registering and receiving

registration acceptance from communication undertaker (see Figure 20). In Nakamura the registration and acceptance of registration is from communication undertaker and not from advertisement apparatuses 5, 6 and 7. Nevertheless, in the system of Nakamura it would have been obvious and cost efficient for subscriber telephone set to have a contract directly with the advertisers (apparatuses 5, 6 and 7) in order to save money by cutting the middleman/ communication undertaker.

With respect to the advertisement broadcast device able to transmit the advertisement data to the terminal management device at arbitrary times without intervening action from a user of the portable telephone communication terminal. Kenney teaches a system and method for providing selected video images to local telephone stations. "the monitor 18 would **display informational screens for a period of 8-10 seconds each when the phone is not in use.** These still images are stored in a memory module 38, which could be a disk drive, in the phone. In some cases, the data could be downloaded from a central administration point" (col. 4, lines 27-32). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the advertisement broadcast device able to transmit the advertisement data to the terminal management device at arbitrary times without intervening action from a user of the portable telephone communication terminal because such a modification would attract passerby to the telephone terminals.

With respect to claims 2, 6, 10, Nakamura further teaches that when a registration cancel request for said portable telephone communication terminal is issued, said registration means cancels registration of the first information and the

second information, and said notification means notifies said advertisement broadcast device of cancellation of registration of said portable telephone communication terminal (1303 and 1304).

Response to Arguments

5. Applicant argues that the exchange 4 of Nakamura does not notify the advertisement apparatus 6 of a registration request. The Examiner wants to point out that exchange 4 has to make sure that telephone set 1 is within the contracted (registered) time zone in order to give the okay to the advertisement apparatus to transmit the ads. The act of exchange 4 to connect the telephone set and advertisement apparatus into communication state is in fact, a notification to the advertisement apparatus that telephone set 1 is within the contracted/registered time zone in order for the ads to be transmitted to telephone set 1.

6. Applicant argues that Nakamura doesn't teach the advertisement apparatus sending a registration acceptance in response to a registration request (see above rejection for rationale).

7. Applicant argues that Nakamura in combination with Kenney do not teach an advertisement broadcast device transmitting advertisement data to a terminal device at arbitrary times after sending registration acceptance. The Examiner disagrees and wants to point out that the claims are were rejected under the doctrine of 103 and that

Nakamura teaches advertisement apparatus transmitting advertisement data to exchange 4 in order to be received by subscriber telephone set 1 after information of registration is obtained and the telephone is in use (see above explanation). Kenney was only cited for teaching sending display information at arbitrary times when the telephone is not in use. Nakamura was combined with Kenney to teach the claimed invention.

Point of contact

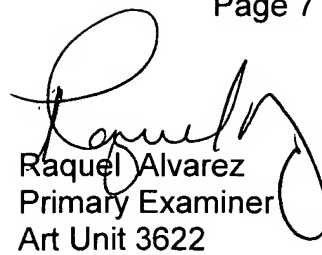
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
12/20/2007